

### REMARKS

The Office Action has been carefully considered. The present amendment is intended to be a complete reply thereto and to place the case in condition for allowance.

Claim 25 has been amended to overcome the rejection under 35 U.S.C. § 112, second paragraph, inadvertently stated in the Office Action to apply to claim 15, by clarifying that “an acid or acid-anhydride polyolefin resin” contains “an carboxyl or anhydride groups.” Claims 29-30 have been added. Claim 29 is a product by the process of claim 1. Claim 30 has support in the specification on page 1, second full paragraph.

#### THE CLAIMS ARE NOT INDEFINITE

Claims 15 (25), 16, and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 15, the Examiner alleged that the claim is vague and indefinite because it is not clear that “containing carboxyl or anhydride group” refers to “an acid of acid-anhydride polyolefin resin” or the “polyester” or both. The specific language referred to by the examiner does not exist in claim 15; however, Applicant believes that the Examiner intends the rejection for claim 25 rather than claim 15. Therefore, claim 25 has been amended to specifically claim that the “acid or acid-anhydride polyolefin resin” contains the “carboxyl or anhydride groups.”

With regard to claims 16 and 18, the Examiner alleged that the claims are vague and indefinite because “it is not clear how the *non-metallic* chemical coating of step (b) comprises chromium which is a metal.” The term “non-metallic” coating is defined on page 3, last

paragraph. The chromium in claims 16 and 18 are elemental chromium. The “non-metallic” coating of claim 1 refers to a coating not comprising atoms bonded by metallic bonding. Whilst some of the elements in the coating disclosed in the present application can sometimes be characterized by their metallic bonding, derivatives of these elements do not show metallic bonding; and these derivatives are, therefore, not excluded by claim 1.

For the above reasons, claims 16, 18 and 25 are not indefinite. Therefore, withdrawal of the rejections is respectfully solicited.

#### THE CLAIMS ARE NOT OBVIOUS

Claims 1-15, 17-23, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 544 040 A1 (EP ‘040). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2143.

The Examiner fails to produce a *prima facie* case of obviousness. First, EP ‘040 does not teach or suggest all the claim limitations. The present invention requires the coating of a mild steel strip. EP ‘040 teaches the coating of titanium or titanium alloy. Because titanium and steel are not the same composition, EP ‘040 does not teach or suggest all the claim limitations.

Further, in regard to claim 12, the Examiner took the position that, although EP ‘040 does not teach a temperature at which spraying occurs, one of ordinary skill in the art can only

*“assume* that spraying occurred at room temperature” (emphasis added). An assumption by the Examiner is not automatically read into the disclosure of the prior art without any references or reasoning to support the assumption. Therefore, EP ‘040 has not teach a temperature where spraying occurs, as claimed by claim 12.

Second, the Examiner fails to provide a suggestion or motivation to modify the teaching of EP ‘040 to arrive at the present invention. In the rejection, the Examiner alleges that it would have been obvious to one of ordinary art to substitute steel for titanium, but no suggestion or motivation is specified. As a matter of fact, EP ‘040 teaches away from the substitution of steel for titanium. EP ‘040, as noted by the Examiner in the Office Action, teaches that titanium alloys are used as a replacement for stainless steel to save weight. Thus, the reference teaches a motivation to substitute titanium for steel, but not the other way around, because of the lighter specific weight of titanium.

Further, the Examiner has used hindsight in coming to the conclusion that a person skilled in the art, on reading EP ‘040, would be led towards applying the protective coating disclosed in the reference to mild steel. While EP ‘040 teaches that stainless steel can be a replacement for titanium or titanium alloy in the specialized field of aircraft components coming into contact with hydraulic fluid (page 3, lines 46-48 with particular emphasis on the words “in these applications”), EP ‘040 is silent on the possibility of mild steel being suitable for the coating. Furthermore, it is submitted that the field of coating titanium or titanium alloys is quite divorced from that of coating mild steel and a person of ordinary skill in the art would not be motivated to apply the teachings of EP ‘040 to mild steel.

Therefore, because EP ‘040 fails to teach or suggest all the claim limitations and because the Examiner fails to provide a suggestion or motivation to modify the teaching of EP ‘040 to

arrive at the present invention, a *prima facie* case of obviousness has not been established. Thus, the rejection under 35 U.S.C. § 103(a) over EP '040 is improper and should be withdrawn.

Claims 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 544 040 A1 (EP '040) in view of WO 97/35716 (WO '716). Applicant respectfully traverses the rejection.

The references, taken alone or in combination, do not disclose or suggest applicant's claimed invention. The deficiencies of EP '040 are discussed above. The Examiner relies on WO '716 to teach coatings with thermoplastic resins including polyethylene terephthalate and polypropylene. However, because EP '040 is deficient in disclosing the substances of claims 1-15, 17-23, and 28, this deficiency is not satisfied by WO '716. Accordingly, EP '040 in view of WO '716 do not render claims 24-27 obvious with in the meaning of 35 U.S.C. § 103(a). Therefore, the rejection is improper and should be withdrawn.

## CONCLUSION

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Applicant has responded to the Office action mailed December 18, 2001. All of the claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

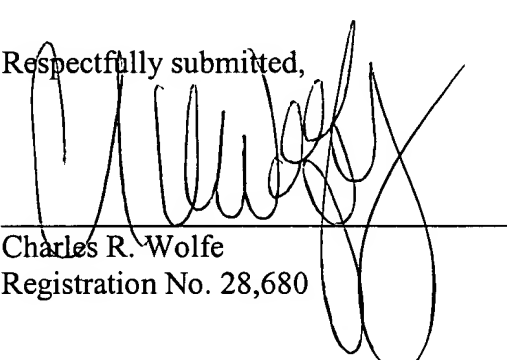
Please charge any shortage or credit any overpayment of fees to BLANK ROME  
COMISKY & McCAULEY LLP, Deposit Account No. 23-2185 (111869-00113). In the event  
that a petition for an extension of time is required to be submitted herewith and in the event that  
a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R.  
1.136(a) for an extension of time for as many months as are required to render this submission  
timely.

Any fees due are authorized above.

Date: 3/18/2002

By:

Respectfully submitted,

  
\_\_\_\_\_  
Charles R. Wolfe  
Registration No. 28,680

BLANK ROME COMISKY & McCAULEY LLP  
900 17<sup>th</sup> Street, NW, Suite 1000  
Washington, DC 20006  
Telephone: 202-530-7400  
Facsimile: 202-463-6915

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

IN THE CLAIMS:

25. (Amended)      A process according to claim 24 wherein the bonding layer comprises a polyester, or an acid or acid-anhydride resin, said acid or acid-anhydride containing carboxyl or anhydride groups.